

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

066491-00007

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on _____

Signature _____

Typed or printed name _____

Application Number

10/686,353

Filed

10/14/2003

First Named Inventor

Robert E. Boyd

Art Unit

3728

Examiner

Mohandes

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/David R. Jaglowski/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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January 14, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 1.16. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

Claims 11, 17-18, 37, and 40-41 are on appeal. Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0092203 to Hardt ("the Hardt '203 publication") in view of U.S. Patent No. 5,218,056 to Santiyanont et al. ("Santiyanont '056").

The Office has failed to provide factual evidence sufficient to support a rejection of claims requiring the provision of an insole or shoe sole including a first elastomeric pad positioned to contact a metatarsus section of a foot and a second elastomeric pad positioned to contact a heel portion of a foot, with the rebound of the first pad being greater than the rebound of the second pad. Such a failure constitutes clear error and requires reversal of the present rejections. The Office cites to column 4, lines 63-68, column 5, lines 1-4, and table 3 of Santiyanont '056 in support of a general allegation that the prior art discloses insoles and/or soles having first and second pads with differing rebound properties. *See* Reply filed December 13, 2007 at p. 2. However the cited material only describes the properties of several test specimens of elastomers, and otherwise fails to describe or suggest that multiple and different elastomeric pads should be combined within a single insole or sole so as to provide greater rebound in the forefoot in order to manipulate energy return. The cited table and description of material tests, without more, is insufficient to establish the obviousness of the claimed invention as a matter of law. MPEP 2143.01(III); *KSR v. Teleflex, Inc.*, slip op. at 14 ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.").

The Office's basic allegation is that Santiyanont '056 discloses "using [a] midsole/insole with first and/or second pad where the rebound of the first pad differing from the rebound rate of the second pad to provide a variable yet large range of cushioning effects, which is necessary for use in different sports activity." However this allegation of both structure and rationale clearly extends beyond the disclosure of the Santiyanont reference, so as to constitute both impermissible hindsight and clear error. With regard to both structure and rationale, Santiyanont

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

introduces its invention by stating that:

An insole/midsole component [in footwear] can be constructed from such an elastomer to have a required hardness, compression set and a required percentage rebound resilience at constant thickness by varying the degree of cross-linking. In consequence, different insole/midsole components [in footwear] can provide a *variable yet large range of cushioning effects*, which is necessary for potential users of the footwear having *different body weight ranges*, and also for use in *different sports activities*.

Santiyanont '056 at col. 1 ll. 36-44 (emphasis added). *See also id.* at abstract ("[The elastomer] is therefore highly suitable for insole and/or midsole components in footwear."). These statements cannot be read in isolation, and must be combined with other portions of the Santiyanont specification that introduce an entire insole as an insole component of footwear. Most notably, the Santiyanont disclosure distinguishes its invention from the prior art by stating that "it has also been found that any one of the [prior art] insoles is only useful for a very limited range of body weight of potential users for the footwear," Santiyanont '056 at col. 1 ll. 62-65, and claiming that "[an] advantage of the invention is that a range of insole/midsole components can be provided having shock-absorbing and attenuating qualities, *which components each cover a large range of potential footwear user body weights*, and a range of different sport activities or casual walking." *Id.* at col. 2 ll. 20-25 (emphasis added). These statements clearly indicate that different insoles/midsoles can be used in the same shoe or shoe design to accommodate different body weight ranges and/or different sports activities, but do not disclose or suggest that different elastomeric pads are combined within the same insole/midsole based on whether the user is a heavier person, or a lighter person, or a runner, or a walker. The Office has not advanced a logical and credible explanation for how different elastomeric pads within a single insole would "provide a variable range of cushioning effects" and "each cover a large range of potential footwear user body weights" as described by Santiyanont. The Office's hindsight-driven insight that such properties could instead be varied within the same insole for use in different sports

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

activities is clearly distinct from the actual disclosure of the Santiyanont reference.

With particular regard to the disclosed structure, the Office has failed to respond to or otherwise rebut arguments that Santiyanont discusses the invention only in a manner consistent with a 'same material' interpretation. Santiyanont identifies an "insole portion 16," an "insole or midsole portion 36," and an "insole/midsole portion 36" and differentiates such structure from the insole or midsole component of a shoe, *id.* at col. 2 l. 58 to col. 3 l. 5 and Figs. 1B and 2, but at no time describes the portions as a "component" so as to support the Office's allegation that Santiyanont disclosed different insole [sub]components combined within the same insole. At its greatest level of detail, Santiyanont describes an illustrated embodiment in which "insole pads 22 and 24 are made of elastomer according to the invention *such as Specimen A* referred to in Table 2," *id.* at col. 2 ll. 63-65 and Fig. 1B (note singular use of elastomer and use of same material) (emphasis added), and in the alternative states that "in place of two pads as shown in FIGS. 1 to 3, *a single pad of elastomeric material* extending from the forefoot to the heel may be provided," *id.* at col. 3 ll. 39-42 (emphasis added). This description of embodiments having pads constructed from a single material and an embodiment including only a single continuous pad all weigh against an alleged disclosure/teaching of a single insole or midsole combining different pad materials having different properties. If such an embodiment was envisioned by Santiyanont, then quite simply it would have been discussed, however briefly, within the context of the disclosed insole portions in the same manner as the other variations discussed in the detailed description.

Even in constructing a *prima facie* case for obviousness, the Office may not simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense, but must point to some concrete evidence in the record in support of its findings. *In re Zurko*, 258 F.3d 1371, 1385 (Fed. Cir. 2001). This burden was not altered by the Supreme Court's decision in *KSR*, which was based on a developed evidentiary record that included (1) an adjustable pedal structure whereby, when the pedal location is adjusted, one of the pedal's pivot points stays fixed; (2) a patent disclosing a pedal with an

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

electronic sensor on a pivot point in the pedal assembly; and (3) a patent teaching that sensors should be put on a fixed part of a pedal assembly, so that it would be obvious to combine an adjustable pedal assembly with a fixed pivot point with a pivot-mounted pedal position sensor. *See KSR*, slip op. at pp. 6-7. The Office has failed to provide record evidence of either a structure providing two different insole pads combined within a single insole or sole so as to provide greater rebound in the forefoot for any stated purpose, or a stated rationale that would lead a person of ordinary skill to specifically vary a rebound property to provide a greater rebound in the forefoot than the heel in order to obtain the claimed result. Thus the present rejections under § 103 are deficient and must be withdrawn.

Respectfully submitted,

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